



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,393	04/13/2006	Takayuki Watanabe	20570/0204294-US0	8589

7278 7590 03/20/2009
DARBY & DARBY P.C.
P.O. BOX 770
Church Street Station
New York, NY 10008-0770

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
----------	--------------

1794

MAIL DATE	DELIVERY MODE
-----------	---------------

03/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/595,393	Applicant(s) WATANABE, TAKAYUKI	
	Examiner ALICIA CHEVALIER	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: ____. |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :1/2/08, 12/19/06, 7/21/06, 4/13/06.

Art Unit: 1794

DETAILED ACTION

1. Claims 1-4 are pending in the application.
2. Amendments to claims, filed on April 13, 2006, have been entered in the above-identified application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “rutile type titanium oxide” in claim 1 is unclear and renders the claims vague and indefinite. The addition of the word “type” to an otherwise definite expression extends the scope of the expression so as to render it indefinite.

The phrase “each of the layers A and B has voids formed by drawing and is independently formed from a resin composition containing a thermoplastic resin” in claim 1 is unclear and renders the claims vague and indefinite. It is unclear whether both layers contain the resin composition or if only one layer is required to contain the resin. For example is layer B only a porous layer of titanium oxide and layer A a voided thermoplastic resin with fine powder inside or outside of the voids.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Laney et al. (U.S. Patent No. 6,846,606).

Regarding Applicant's claims 1 and 3, Laney discloses a reflecting film (*col. 3, line 45*) comprising a layer B that contains rutile type titanium oxide (*col. 7, lines 38-39 and col. 10, line 16*) and a layer A that contains fine powder filler other than rutile type titanium oxide (*col. 7, lines 19-20*), wherein the rutile type titanium oxide has a vanadium content of 5 ppm or less (*col.*

Art Unit: 1794

10, line 16), and wherein the layer A is positioned outermost on the side of a surface used for reflection (*figure 4*), each of the layers A and B has voids (*col. 7, line 19 and 48*) in a thermoplastic aliphatic polyester, which is a polylactic acid based resin (*col. 8, lines 39-51*).

The limitation “formed by drawing and is independently formed from a resin composition” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

Regarding Applicant’s claim 2, Laney discloses that the reflecting film has a two-layer construction including the layer A and the layer B, or a three-layer construction including the layer A, the layer B, and the layer A in this order (*figure 4*).

Regarding Applicant’s claim 4, the preamble “a reflecting plate for a liquid crystal display device” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

7. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Schiffer et al. (U.S. Patent Application Publication No. 2002/0098341).

Regarding Applicant’s claims 1 and 3, Schiffer discloses a film (*title*) comprising a layer B that contains rutile type titanium oxide (*page 3, paragraph [0027]*) and a layer A that contains fine powder filler other than rutile type titanium oxide (*combination of these particles, page 3,*

Art Unit: 1794

paragraph [0027]), wherein the futile type titanium oxide has a vanadium content of 5 ppm or less (*page 3, paragraph [0027]*), and wherein the layer A is positioned outermost on the side of a surface used for reflection (*figure 4*), each of the layers A and B has voids (*page 2, paragraph [0024]*) in a thermoplastic aliphatic polyester, which is a polylactic acid based resin (*page 2, paragraph [0025]*). The film is deemed to be capable of reflecting, since any sheet will reflect light, radiation, etc. to a degree.

The limitation “formed by drawing and is independently formed from a resin composition” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

Regarding Applicant’s claim 2, Schiffer discloses that the reflecting film has a two-layer construction including the layer A and the layer B, or a three-layer construction including the layer A, the layer B, and the layer A in this order (*figure 4*).

Regarding Applicant’s claim 4, the preamble “a reflecting plate for a liquid crystal display device” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

Art Unit: 1794

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alicia Chevalier/
Primary Examiner, Art Unit 1794
3/19/2009